

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: : Before the Examiner:
Truty et al. : Wang, Liang-che A.
:
Serial No.: 10/626,183 : Group Art Unit: 2155
:
Filing Date: July 24, 2003 :
:
Title: METHOD AND SYSTEM : IBM Corporation
FOR MERGING TOPICALLY : Intellectual Property Law
RELATED E-MAIL IN A : 11400 Burnet Road
COLLABORATIVE WORK : Austin, Texas 78758
ENVIRONMENT :
:

REPLY UNDER 37 C.F.R. §1.111

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action having a mailing date August 3, 2007, having a three-month shortened statutory period for response set to expire on November 3, 2007, please reconsider the rejections of the claims in view of the following amendments and remarks:

Amendments to the Claims are reflected in the listing of claims which begin on page 2 of this paper.

Remarks begin on page 8 of this paper.

IN THE CLAIMS

Please amend claims 8 and 13 as indicated below.

This listing of claims will replace all prior versions, and listings, of claims in the application.

Listing of Claims:

Claim 1 (original) A method for collating e-mail comprising:

- (a) differencing at least one first e-mail message and a second e-mail message wherein said at least one first e-mail message is prior to said second e-mail message, said differencing generating a set of unmatched text and a set of matched text;
- (b) matching said set of matched text against a collated message file, said matching step identifying a position in said collated message file at an end of a portion of said collated message file corresponding to said set of matched text; and
- (c) inserting said set of unmatched text in said collated message file at said position.

Claim 2 (original) The method of claim 1 wherein said at least one first e-mail message comprises a plurality of first e-mail messages, the method further comprising:

- (d) repeating step (a) for each e-mail message of said plurality of first e-mail messages; and
- (e) selecting one of said plurality of e-mail messages having a largest set of matched text, and wherein, in step (b), said largest set of matched lines is matched against said collated message file.

Claim 3 (original) The method of claim 2 further comprising selectively adding a user-configurable identifier to said set of unmatched text inserted in step (c).

Claim 4 (original) The method of claim 1 wherein said at least one first e-mail message and said second e-mail message comprise a set of topically-related e-mail

selected in response to a preselected pattern in a header portion of each e-mail of said set of topically-related e-mail.

Claim 5 (original) The method of claim 4 further comprising:

(d) searching each e-mail message of said set of topically-related e-mail for at least one member of a preselected set of prepended identifiers;

(e) if said at least one member of a preselected set of prepended identifiers matches a portion of said message of said set of topically-related messages:

(i) selecting a portion of said message not having said prepended identifier;

(ii) inserting said portion from substep (i) into said collated message file at a position following a portion matching a set of text having said at least one member of a preselected set of prepended identifiers; and

(iii) bypassing steps (a)-(c).

Claim 6 (original) The method of claim 5 further comprising:

(f) extracting said set of text having said at least one member of a preselected set of prepended identifiers;

(g) stripping said at least one member of a preselected set of prepended identifiers from said set of text; and

(h) matching a set of text from step (g) against said collated message file, wherein said position in substep (e)(ii) comprises a position at an end of a portion of said collated message file matching a set of text from step (g).

Claim 7 (original) The method of claim 5 wherein said step of searching each e-mail message of said set of topically-related e-mail comprises searching each e-mail in chronological order of said set of topically-related e-mail.

Claim 8 (currently amended) A computer program product ~~in a tangible storage medium tangibly embodied on a computer readable medium~~, the program product for collating e-mail comprising programming instructions for:

- (a) differencing at least one first e-mail message and a second e-mail message wherein said at least one first e-mail message is prior to said second e-mail message, said differencing generating a set of unmatched text and a set of matched text;
- (b) matching said set of matched text against a collated message file, said matching step identifying a position in said collated message file at an end of a portion of said collated message file corresponding to said set of matched text; and
- (c) inserting said set of unmatched text in said collated message file at said position.

Claim 9 (original) The program product of claim 8 wherein said at least one first e-mail message comprises a plurality of first e-mail messages, the program product further comprising programming instructions for:

- (d) repeating (a) for each e-mail message of said plurality of first e-mail messages; and
- (e) selecting one of said plurality of e-mail messages having a largest set of matched text, and wherein, in (b), said largest set of matched lines is matched against said collated message file.

Claim 10 (original) The program product of claim 8 further comprising programming instructions for selectively adding a user-configurable identifier to said set of unmatched text inserted in (c).

Claim 11 (original) The program product of claim 8 wherein said at least one first e-mail message and said second e-mail message comprise a set of topically-related e-mail selected in response to a preselected pattern in a header portion of each e-mail of said set of topically-related e-mail.

Claim 12 (original) The program product of claim 11 further comprising programming instructions for:

- (d) searching each e-mail message of said set of topically-related e-mail for at least one member of a preselected set of prepended identifiers;

(e) if said at least one at least one member of a preselected set of prepended identifiers matches a portion of said message of said set of topically-related messages:

(i) selecting a portion of said message not having said prepended identifier;

(ii) inserting said portion from (i) into said collated message file at a position following a portion matching a set of text having said at least one member of a preselected set of prepended identifiers; and

(iii) bypassing (a)-(c).

Claim 13 (currently amended) The program product of claim [[5]] 12 further comprising programming instructions for:

(f) extracting said set of text having said at least one member of a preselected set of prepended identifiers;

(g) stripping said at least one member of a preselected set of prepended identifiers from said set of text; and

(h) matching a set of text from (g) against said collated message file, wherein said position in (e)(ii) comprises a position at an end of a portion of said collated message file matching a set of text from (g).

Claim 14 (original) The program product of claim 12 wherein said programming instructions for searching each e-mail message of said set of topically-related e-mail comprises programming instructions for searching each e-mail in chronological order of said set of topically-related e-mail.

Claim 15 (original) A data processing system for collating e-mail comprising:

(a) circuitry operable for differencing at least one first e-mail message and a second e-mail message wherein said at least one first e-mail message is prior to said second e-mail message, said differencing generating a set of unmatched text and a set of matched text;

(b) circuitry operable for matching said set of matched text against a collated message file, said matching step identifying a position in said collated

message file at an end of a portion of said collated message file corresponding to said set of matched text; and

(c) circuitry operable for inserting said set of unmatched text in said collated message file at said position.

Claim 16 (original) The data processing system of claim 15 wherein said at least one first e-mail message comprises a plurality of first e-mail messages, the data processing system further comprising:

(d) circuitry operable for repeating (a) for each e-mail message of said plurality of first e-mail messages; and

(e) circuitry operable for selecting one of said plurality of e-mail messages having a largest set of matched text, and wherein, in (b), said largest set of matched lines is matched against said collated message file.

Claim 17 (original) The data processing system of claim 15 further comprising circuitry operable for selectively adding a user-configurable identifier to said set of unmatched text inserted in (c).

Claim 18 (original) The data processing system of claim 15 wherein said at least one first e-mail message and said second e-mail message comprise a set of topically-related e-mail selected in response to a preselected pattern in a header portion of each e-mail of said set of topically-related e-mail.

Claim 19 (original) The data processing system of claim 18 further comprising:

(d) circuitry operable for searching each e-mail message of said set of topically-related e-mail for at least one member of a preselected set of prepended identifiers;

(e) circuitry operable for, if said at least one member of a preselected set of prepended identifiers matches a portion of said message of said set of topically-related messages:

(i) selecting a portion of said message not having said prepended identifier;

- (ii) inserting said portion from (i) into said collated message file at a position following a portion matching a set of text having said at least one member of a preselected set of prepended identifiers; and
- (iii) bypassing (a)-(c).

Claim 20 (original) The data processing system of claim 19 further comprising:

- (f) circuitry operable for extracting said set of text having said at least one member of a preselected set of prepended identifiers;
- (g) circuitry operable for stripping said at least one member of a preselected set of prepended identifiers from said set of text; and
- (h) circuitry operable for matching a set of text from (g) against said collated message file, wherein said position in (e)(ii) comprises a position at an end of a portion of said collated message file matching a set of text from (g).

REMARKS

Claims 1-20 are pending. Claims 8-14 are rejected under 35 U.S.C. §101. Claims 5-7, 11-14 and 19-20 are rejected under 35 U.S.C. §112, second paragraph. Claims 1-4, 8-11 and 15-18 are rejected under 35 U.S.C. §102(e). Applicants address these rejections below.

As indicated above, Applicants amended claims 8 and 13. The preamble of claim 8 was amended to clarify the claimed subject matter and not to overcome prior art as discussed further below. Further, claim 13 was amended to correct a typographical mistake and not to overcome prior art.

Applicants thank Examiner Wang for discussing the rejections with Applicants' Attorney, Bobby Voigt, on October 24, 2007.

I. REJECTIONS UNDER 35 U.S.C. §101:

The Examiner has rejected claims 8-14 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Office Action (8/3/2007), page 2. In particular, the Examiner asserts that claims 8-14 are directed to software per se and therefore are not directed to statutory subject matter. *Id.*

As indicated above, Applicants amended the preamble of claim 8 to include the aspect of a computer program product tangibly embodied on a computer readable medium. As discussed with Examiner Wang on October 24, 2007, Examiner Wang agreed that by modifying the preamble of claim 8 in such a manner, that claims 8-14 would be allowable under 35 U.S.C. §101. Accordingly, Applicants respectfully request the Examiner to withdraw the rejections of claims 8-14 under 35 U.S.C. §101.

II. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH:

The Examiner has rejected claims 5-7, 11-14 and 19-20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Office Action (8/3/2007), page 2. In particular, the Examiner asserts that the limitation of "bypassing (a)-(c)" in claims 5, 11 and 19 renders claims 5-7, 11-14 and 19-20 vague

and indefinite under M.P.E.P. §2173.05(c). *Id.* at pages 2-3. Applicants respectfully traverse.

M.P.E.P. §2173.05(c) states that the use of a narrow numerical range that falls within a broader range in the same claim may render the claim indefinite when the boundaries of the claim are not discernable. In particular, M.P.E.P. §2173.05(c) stands for the proposition that in those instances where it is not clear whether the claimed narrower range is a limitation, a rejection under 35 U.S.C. §112, second paragraph, should be made. For example, the claim limitation of "a temperature of between 45 and 75 degrees Celcius, preferably between 50 and 60 degrees Celcius" has been held to be indefinite. M.P.E.P. §2173.05(c). However, claims 5, 11 and 19 do not recite any numerical ranges. In particular, claims 5, 11 and 19 do not recite a narrow and a broader numerical range in the same claim. Therefore, M.P.E.P. §2173.05(c) does not support the proposition that claims 5-7, 11-14 and 19-20 are indefinite under 35 U.S.C. §112, second paragraph. Accordingly, Applicants respectfully assert that claims 5-7, 11-14 and 19-20 are allowable under 35 U.S.C. §112, second paragraph, and respectfully request the Examiner to withdraw the rejections of claims 5-7, 11-14 and 19-20 under 35 U.S.C. §112, second paragraph.

Further, a rejection under 35 U.S.C. §112, second paragraph, is not appropriate, when the scope of the claimed subject matter can be determined by one having ordinary skill in the art. M.P.E.P. §2173. Applicants respectfully assert that one having ordinary skill in the art can determine the scope of the limitation of "bypassing steps (a)-(c)," as recited in claims 5, 11 and 19. The Examiner has not provided any evidence that a person of ordinary skill in the art would not be able to determine the scope of the claimed subject matter in claims 5-7, 11-14 and 19-20. Consequently, Applicants respectfully assert that claims 5-7, 11-14 and 19-20 are allowable under 35 U.S.C. §112, second paragraph, and respectfully request the Examiner to withdraw the rejections of claims 5-7, 11-14 and 19-20 under 35 U.S.C. §112, second paragraph.

III. REJECTIONS UNDER 35 U.S.C. §102(e):

The Examiner has rejected claims 1-4, 8-11 and 15-18 under 35 U.S.C. §102(e) as being anticipated by Chang et al. (U.S. Patent Application Publication No. 2004/0119740) (hereinafter "Chang"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

Applicants respectfully assert that Chang does not disclose "differencing at least one first e-mail message and a second e-mail message wherein said at least one first e-mail message is prior to said second e-mail message, said differencing generating a set of unmatched text and a set of matched text" as recited in claim 1 and similarly in claims 8 and 15. The Examiner cites paragraphs [0007 and 0054] of Chang as disclosing the above-cited claim limitations. Office Action (8/3/2007), page 4. Applicants respectfully traverse.

Chang instead discloses that when an electronic message is displayed, a portion of the electronic message is elided to aid in the viewing experience. [0007]. Chang further discloses that the method of viewing a first electronic message comprises: identifying an extraneous portion within a second electronic message; eliding the extraneous portion within the second electronic message; and generating the first electronic message wherein the first electronic message includes the second electronic message with the extraneous portion of the second electronic message suppressed. [0007]. Chang further discloses that repeated text within the received electronic message is detected. [0054]. Hence, Chang discloses that a portion of a first electronic message is stricken out and generating a second electronic message that includes the first electronic message without the portion stricken out.

There is no language in the cited passages that teaches that the differencing generating a set of unmatched text and a set of matched text. Thus, Chang does not disclose all of the limitations of claims 1, 8 and 15, and thus Chang does not anticipate claims 1, 8 and 15. M.P.E.P. §2131.

Applicants further assert that Chang does not disclose "matching said set of matched text against a collated message file, said matching step identifying a position in said collated message file at an end of a portion of said collated message file corresponding to said set of matched text" as recited in claim 1 and similarly in claims 8 and 15. The Examiner cites paragraphs [0054-0058] of Chang as teaching the above-cited claim limitations. Office Action (8/3/2007), page 4. Applicants respectfully traverse.

Chang instead discloses that repeated text within the received electronic message is detected. [0054]. Chang further discloses that portions of the repeated text are suppressed in response to a location of new text within the received electronic message. [0055]. Chang additionally discloses that the portion of repeated text that is not suppressed may be utilized to provide context to the new text that is contained within the received electronic message. Hence, Chang discloses detecting repeated text and suppressing portions of the repeated text in response to a location of new text within the received electronic message.

There is no language in the cited passages that discloses matching a set of matched text against a collated message file. Neither is there any language in the cited passages that discloses that the matching step identifying a position in the collated message file at an end of a portion of the collated message file corresponding to the set of matched text. Thus, Chang does not disclose all of the limitations of claims 1, 8 and 15, and thus Chang does not anticipate claims 1, 8 and 15. M.P.E.P. §2131.

Applicants further assert that Chang does not disclose "inserting said set of unmatched text in said collated message file at said position" as recited in claim 1 and similarly in claims 8 and 15. The Examiner cites paragraph [0066] of Chang as disclosing the above-cited claim limitation. Office Action (8/3/2007), page 4. Applicants respectfully traverse.

Chang instead discloses that the screen shot 700 displays a subject header 705 and a plurality of messages 710, 720, 730, and 740. [0066]. Chang further discloses that in one embodiment, the subject header 705 displays information relating to the

most current message 740. [0066]. Chang additionally discloses that the plurality of messages 710, 720, 730, and 740 are shown with header information suppressed. [0066]. Hence, Chang discloses messages that have their header information suppressed.

There is no language in the cited passage that discloses inserting the set of unmatched text in the collated message file at the position. Thus, Chang does not disclose all of the limitations of claims 1, 8 and 15, and thus Chang does not anticipate claims 1, 8 and 15. M.P.E.P. §2131.

Claims 2-4, 9-11 and 16-18 each recite combinations of features of independent claims 1, 8 and 15, respectively, and hence claims 2-4, 9-11 and 16-18 are not anticipated by Chang for at least the above-stated reasons that claims 1, 8 and 15, respectively, are not anticipated by Chang.

Claims 2-4, 9-11 and 16-18 recite additional features, which, in combination with the features of the claims upon which they depend, are not anticipated by Chang.

For example, Chang does not disclose "wherein said at least one first e-mail message comprises a plurality of first e-mail messages, the method further comprising: (d) repeating step (a) for each e-mail message of said plurality of first e-mail messages; and (e) selecting one of said plurality of e-mail messages having a largest set of matched text, and wherein, in step (b), said largest set of matched lines is matched against said collated message file" as recited in claim 2 and similarly in claims 9 and 16. The Examiner cites paragraph [0066] and Figure 7 of Chang as disclosing the above-cited claim limitations. Office Action (8/3/2007), page 5. Applicants respectfully traverse.

Chang instead discloses that the screen shot 700 displays a subject header 705 and a plurality of messages 710, 720, 730, and 740. [0066]. Chang further discloses that in one embodiment, the subject header 705 displays information relating to the most current message 740. [0066]. Chang additionally discloses that the plurality of messages 710, 720, 730, and 740 are shown with header information suppressed. [0066]. Hence, Chang discloses messages that have their header information suppressed.

There is no language in the cited passage or depicted in Figure 7 that discloses repeating step (a) for each e-mail message of the plurality of first e-mail messages. Neither is there any language in the cited passage or depicted in Figure 7 that discloses selecting one of the plurality of e-mail messages having a largest set of matched text. Neither is there any language in the cited passage or depicted in Figure 7 that discloses that in step (b), the largest set of matched lines is matched against the collated message file. Thus, Chang does not disclose all of the limitations of claims 2, 9 and 16, and thus Chang does not anticipate claims 2, 9 and 16. M.P.E.P. §2131.

As a result of the foregoing, Applicants respectfully assert that not each and every claim limitation was found within Chang, and thus claims 1-4, 8-11 and 15-18 are not anticipated by Chang. M.P.E.P. §2131.

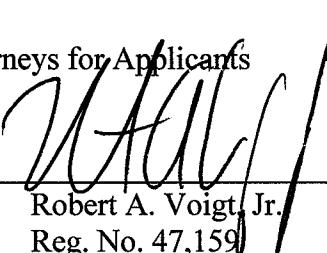
IV. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 1-20 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

WINSTEAD P.C.

Attorneys for Applicants

By: 

Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, TX 75201
(512) 370-2832

Austin_1 510751v.1